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In re Application of:
Yoshihisa Itoh, et al.
Application Serial No.: 09/978,076
Filed: October 17, 2001
For: **HOLOGRAM RECORDING AND
REPRODUCING APPARATUS**

SUA SPONTE
DECISION WITHDRAWING
HOLDING OF ABANDONMENT

This is a decision, *sua sponte*, withdrawing the holding of abandonment of the above-identified application.

A review of the subject application reveals that non-final Office action was mailed on February 11, 2004, setting forth a rejection of the claims, but also objecting to claim 2, that if re-written to overcome a 35 U.S.C. 112 2nd paragraph rejection and to include all of the limitations of the base claim and any intervening claim, the claim would be allowable. Applicants filed a response on May 11, 2004, amending claim 2, but also adding claims 7 through 12. On June 3, 2004, the examiner correctly prepared and mailed a communication indicating that applicants' May 11, 2004 communication was not fully responsive in accordance with 37 C.F.R. § 1.111, due to a lack of statements regarding novelty with respect to the new claims 7 through 12.

37 C.F.R. § 1.111 Reply by applicant or patent owner to a non-final Office action, states in part:...

- (c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

The non-responsive communication set a one month or thirty day time period for supplying the omission or correction, with extensions of time being permitted, in accordance with 37 C.F.R. §1.135.

§ 1.135 Abandonment for failure to reply within time period, states in part:...

- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted,

applicant may be given a new time period for reply under § 1.134 to supply the omission.

On September 3, 2004, applicants filed a supplemental response with a petition for two month extension of time. Applicants' response included the cancellation of claims 7-12 and a clean copy of all the previously presented and pending claims. On December 14, 2004, the examiner mailed a communication which indicated that the original amendment filed May 11, 2004, was not entered into the record and thus the amendment filed September 3, 2004 was improper since it did not include underlines and deletion lines. It then appears as though the December 14, 2004 communication issues a new non-responsive notice, setting a new one month or thirty day response period to file the omission or correction to the May 11, 2004 amendment, but then in the same communication, indicates that applicants' substitute amendment could not be entered given that the time period for filing a response had expired. On December 30, 2004, applicants paid the balance of a five month extension of time request. On August 17, 2005, applicants sent in a status inquiry and on September 20, 2005, a Notice of Abandonment for failure to respond to the December 14, 2004 communication was mailed.

Given the record above, it is clear that applicant timely filed a response with a two month extension of time on September 3, 2004. It is also evident that applicants' September 3, 2004 submission complied with 37 C.F.R. § 1.121 'Manner of making amendments in applications', which states in part:...

- (c) Claims . Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered). [emphasis added]

Applicants are required under 37 C.F.R. § 1.121, to include a complete listing of all claims ever presented, including the pending claims when submitting an amendment, inclusive of when the amendment is merely the cancellation of claims. Applicants' September 3, 2004 amendment complied with the requirement of 37 C.F.R. § 1.121, specifically, applicants cancelled claims 7 through 12 and provided a complete listing of all the claims. Moreover, the cancellation of claims 7-12 in the September 3, 2004 amendment, resolved the original omission of a statement regarding novelty, i.e., the cancellation of claims 7-12 removed the requirement for a statement of novelty regarding those claims. Therefore, the September 3, 2004 submission should have been entered as being fully responsive to the outstanding non-responsive communication of June 3, 2004.

Although no petition or request to withdraw the holding of abandonment in this application has been filed, the Notice of Abandonment is hereby vacated and the holding of abandonment is withdrawn. Any inconvenience caused petitioner is regretted.

The application file will be forwarded to the Technology Center's technical support staff for entry of both the May 11, 2004 and Sept 3, 2004 amendments. From there, the application file will be forwarded to the examiner for action in appropriate turn.



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